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10/024,496	12/21/2001	Gilles Rubinstenn	05725.0980-00	4463

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,496

Applicant(s)

RUBINSTENN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 and 32-47 are rejected under 35 U.S.C. 101 because the claimed method for providing beauty advice does not recite a limitation in the technological arts. The independently claimed steps of: *obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject; determining local information based on the demographic information; generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information; and presenting the at least one recommendation* are abstract ideas which can be performed mentally without interaction of a physical structure. Said method steps may be understood as merely obtaining an advise from a beauty consultant in a beauty salon. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6-9, 12-18, 20-31, 41-45 and 47 are rejected under 35 U.S.C. 102(e) as being unpatentable over Maloney et al. (WO 01/18674 A2).

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising:

Claim 1. Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer inherently indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (water hardness, pH level) based on the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15).

Claim 3. Obtaining information about recent purchases of cosmetic products from each consumer, and having address information of said each consumer inherently indicates obtaining data on cosmetic usage of others located in the geographic area of the subject (P. 12, L. 17-18).

Claim 6. Obtaining local water hardness and pH level information inherently indicates obtaining ecological data for the geographic area of the subject (P. 10, L. 7-8; P. 11, L. 11-12).

Claim 7. Said method, wherein the personal information further includes lifestyle (P. 7, L. 2).

Claim 8. Said method, wherein the lifestyle information includes at least one of fashion preferences, clothing color preferences, and cosmetic preferences (P. 11, L. 27-30).

Claim 9. Said method, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics (P. 7, L. 1-3).

Claim 12. Receiving over a network, at a site remote from the subject, the personal information about the subject, and transmitting the recommendation to the consumer over the network (P. 4, L. 7-10).

Claim 13. Generating recommendation based on physical characteristics information, the local information, and the variable preference information (P. 4, L. 18-23).

Claim 14. Said method, wherein the variable preference information includes an identification of clothing that the subject intends to wear (P. 7, L. 16-19). Information as to *a suggestion to use at least one product complementary to the identified clothing* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Maloney would be performed the same regardless the content of the recommendation.

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Claim 15. Said method, wherein the identification of clothing is a color of clothing (P. 7, L. 16; P. 11, L. 28).

Claim 16. Said method, wherein the product is a cosmetic product for adding color to a face of the subject (P. 11, L. 28; P. 12, L. 2-3).

Claims 17-18. Accessing the node prior to the time of intended cosmetic application (See claim 1). Information as to *immediately prior, or in an evening before, or in a day of intended cosmetic application* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 20. Obtaining information about recent purchases of cosmetic products from a consumer inherently indicates receiving from the consumer an identification of products at the subject's disposal (P. 12, L. 17-18). Information as to *immediate* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 21. Said method, wherein the physical characteristics information includes at least one of color, tone, texture, elasticity, oiliness, and pH of at least one of the subject's hair and skin (P. 11, L. 9-10).

Claims 22-24. See claim 1.

*Claim 25.* Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer inherently indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); generating a list of a plurality of cosmetic products for the consumer; receiving from the subject a request for cosmetic advice; accessing local information (water hardness, pH level) based on the geographic area (P. 10, L. 7-8; P. 11, L. 11-12); generating at least one recommendation for use of

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at least one cosmetic product based on the personal information and the local information (P. 7, L. 14-15).

Claim 26. Said method, wherein receiving the request occurs via a network and in at least one location remote from a location of the consumer (P. 4, L. 7-10).

Claim 27. A system for providing beauty advice, the system comprising: memory for storing personal information about a subject, and a processor (P. 14, L. 3-12).

Information as to *accessing local information for the geographic area and for generating at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 28, Said processor as in claim 27. Information as to *generating at least one suggestion for clothing based on at least the local information* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

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Claim 29. Said system as in claim 27. Information as to *at least one cosmetic product is chosen from makeup and hair products* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 30. A system for providing beauty advice, the system comprising: a memory including a program that obtains personal and geographic area location information about a consumer (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determines local information (water hardness, pH level) based on the obtained information (P. 10, L. 7-8; P. 11, L. 11-12); generates and presents at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15); and a processor that runs the program (P. 14, L. 3-12).

Claim 31. A computer-readable medium containing instructions for causing a computer to perform a method for providing beauty advice, the method comprising: obtaining personal information and geographic area location information about a consumer (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (water hardness, pH level) based on the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15).

Claim 41. Obtaining information about a geographic area (P. 10, L. 7-8; P. 11, L. 11-12); generating and providing at least one recommendation for use of at least one cosmetic product based on the information (P. 7, L. 14-15).



Claim 42. Said method conducted in a network environment (P. 16, L. 20-34).

Claim 43. Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer inherently indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (water hardness, pH level) based on the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information and presenting the at least one cosmetic analysis (P. 7, L. 14-15).

Claim 44. See claim 43.

Claim 45. Said method conducted in a network environment (P. 16, L. 20-34).

Claim 47. See claim 43.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Anderson (US 2002/0082869).

Claim 10. Maloney teaches all the limitations of claim 10, except that said family history information includes historical physical characteristics information about relatives of the consumer.

Anderson teaches a method and system for providing and updating customized health care over the Internet, wherein personal data of an individual includes age and medical history of the individual's relatives [0016].

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said family history information includes historical physical characteristics information about relatives of the consumer, as disclosed in Anderson, because it would allow to determine and exclude certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a predisposition.

Claims 2, 4-5, 11, 19, 32-40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Maeng, Il-Hee (WO 02/082350).

Claims 2, 4-5, 11, 19 and 46. Maloney teaches all the limitations of claims 2, 4-5, 11, 19, and 46, except that said local information includes climate or weather information.

Maeng, Il-Hee (hereinafter Maeng) teaches a method and system for diagnosing and prescribing care for personal skin, wherein local information obtained for said diagnosing includes various environmental factors, such as weather, temperature, moisture and season information.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said local information includes climate or weather information, as disclosed in Maeng, because it would allow to create a cosmetic composition best suited for a specific climate or weather condition, thereby increase customer satisfaction.

Claim 32. Maloney teaches: Maintaining a plurality of categories, each category being defined by at least one personal characteristic (P. 7, L. 3-12); obtaining information identifying a geographic area where beauty advice is to be dispensed (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); obtaining local information about the geographic area (water hardness, pH level) (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information and at least one of the plurality of categories (P. 7, L. 13-14).

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Maloney does not specifically teach that said local information including a weather forecast for said geographic area.

Maeng, Il-Hee (hereinafter Maeng) teaches a method and system for diagnosing and prescribing care for personal skin, wherein local information obtained for said diagnosing includes various environmental factors, such as weather, temperature, moisture and season information.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said local information includes climate or weather information, as disclosed in Maeng, because it would allow to create a cosmetic composition best suited for a specific climate or weather condition, thereby increase customer satisfaction.

Claim 33. Presenting the recommendations to a user (P. 15, L. 5-12). Information as to “*beauty consultant*” is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Maloney and Maeng would be performed the same regardless who is the user.

Furthermore, Maloney teaches:

Claim 34. Presenting includes organizing recommendations by category (P. 7, L. 5-13).

Claim 35. Obtaining information about recent purchases of cosmetic products from each consumer, and having address information of said each consumer inherently indicates obtaining data on cosmetic usage of others located in the geographic area of the subject (P. 12, L. 17-18).

Claim 36. Said method, wherein the personal information further includes lifestyle (P. 7, L. 2).

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Claim 37. Said method, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics (P. 7, L. 1-3).

Claim 38. See claim 32.

Claim 39. Generating recommendation based on physical characteristics information, the local information, and the variable preference information (P. 4, L. 18-23).

Claim 40. Said method conducted in a network environment (P. 16, L. 20-34).

Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney.

Claim 19. Maloney teaches all the limitations of claim 19, except that suggesting that the consumer maintain a stock of the plurality of cosmetic products.

Official notice is taken that it is well known that there are a lot of consumers using cosmetic product every day.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include: suggesting that the consumer maintain a stock of the plurality of cosmetic products, because without maintaining said stock the consumer may run out of cosmetic product when she/he heeded it most.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

*JP*



**JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**